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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **LARRY D. FORBES**

Serial No.: 09/525,365

Filed: March 15, 2000

Entitled: **NOISE ABATEMENT FILTER**

PATENT No.: 6,408,979

Issued: June 25, 2002

ASSIGNEE: **MAHLE PARR FILTER SYSTEMS INC.****DECLARATION**

CAROLYN J. CAMPBELL, hereby declares:

1. That I have been employed by the firm of Sturm & Fix LLP since October 1976.
2. That part of my job duties is to review the docket for upcoming maintenance fees that are due to the United States Patent and Trademark Office in a timely manner. The docket is generally reviewed at least two (2) months in advance of the 3, 7, and 11 year anniversary dates of the issue date of patent.
3. That at least two months in advance of the anniversary date of the issue date I send out a first letter to the patentee or assignee advising them of the due date of the maintenance fee and request their instructions for payment of the fee. An "Informational Invoice" is attached to that letter showing the amount due and the requested date that we would like to have their instructions for payment or non-payment of the current maintenance fee due. (A blank copy of that letter designated EXHIBIT A is attached hereto.)
4. That if no response is received from the patentee or assignee to the first letter, a second letter is sent out informing the patentee or assignee that we have not received any instructions regarding payment of maintenance fee from our letter previously sent to them. In this letter, we clearly state that if the maintenance fee is not paid, the patent will become abandoned. (A blank copy of that letter designated EXHIBIT B) is attached hereto.
5. That I did send the appropriate letters to Mahle Technology in 2005 and 2006.
6. That on January 25, 2006 at the request of Jennifer Lewis of Mahle Technology, I prepared and mailed an Invoice designated Invoice No. 25899 to Mahle Tennex North

America, 505 E. Madison, Winterset, IA 50273, in the amount of \$1,015 for payment of the first maintenance fee and late payment surcharge. Ms. Lewis requested an Invoice showing all fees that would be due. Ms. Lewis further informed us that Mahle cannot pay from the "Informational Invoice" which was previously sent with the first letter notifying Mahle of the upcoming maintenance fee due. This was an unusual occurrence in that a regular month end Invoice was requested prior to the fee being paid. Receipt of the requested maintenance fee payment from the "Informational Invoice" would be shown on our accounts receivable as a credit balance and would alert us that the payment had not been billed, nor had it been paid. An Invoice is prepared and mailed the same day the fee is paid. Due to the unusual Invoice requested by Ms. Lewis, our billing system failed to generate a credit balance report.

7. That on April 13, 2006 (three months after mailing the requested Invoice), our Des Moines office received and deposited a check from Mahle Technology in the amount of \$1,015 for payment of the current maintenance fee and late payment surcharge. Normally when a maintenance fee payment is received, that payment would go directly into our trust account instead of the regular checking account. That payment would remain in the trust account until the payment is made to the Patent Office. At that time the payment is removed from the trust account and transferred to the regular checking account. Since an Invoice had been rendered for the maintenance fee prior to receiving the payment, the check was deposited into the regular checking account.

8. That my procedure when paying maintenance fees for corporations, etc., is to check their status both in the firm's records and in PAIR. That on or about April 28, 2006, I discovered that Mahle was a LARGE ENTITY instead of a SMALL ENTITY and I asked our Des Moines office to prepare a LOSS OF SMALL ENTITY STATUS which I could then fax to the Patent Office.

9. That I believe at this point there must have been a telephone call or e-mail message to Mahle indicating that additional fees would be required for payment of a LARGE ENTITY, instead of SMALL ENTITY as indicated in Invoice 25899 sent at the request of Jennifer Lewis. (EXHIBIT C)

10. That on April 27, 2006 we received a second payment from Mahle in the amount of \$1,015. After posting the \$1,015 to Mahle's account, it was noticed that the additional amounts due for LARGE ENTITY had not been billed to Mahle.

11. That on April 28, 2006 I prepared and mailed to Mahle Invoice 26502 in the amount of \$515 for the additional government fees for a status of LARGE ENTITY. After posting the payment of \$1,015 to their account it was noted that they had a credit balance of \$500. The \$500 was transferred to another account for them which also had a

maintenance fee due. (EXHIBIT D)

12. That on or about May 1, 2006, I faxed a LOSS OF SMALL ENTITY STATUS to the Patent Office for the patent referenced above, U.S. Patent No. 6,408,979.

13. That knowing that it takes several days for the U.S. Patent Office, Maintenance Fee Division to correct and post updated information, I did not make the payment at this time. If payment for a maintenance fee as a large entity was made prior to the updating of the status of Mahle, the payment would either be entered as a small entity payment rate and the extra monies refunded, or the payment could have been refused. Therefore, my procedure is to wait several days to make sure the Patent Office has posted the updated information.

14. That even though the maintenance fee due was on the docket for June 25, 2006, unfortunately I thought I had paid it so I did not do any follow-up on it and the fee was not paid.

15. That after June 25, 2006, the docketing system showed the Patent as still current. (EXHIBIT E). The file was marked ABANDONED sometime after July 20, 2006. (EXHIBIT F) attached hereto. Sometime after June 25, 2006, seeing the unpaid maintenance fee on the docket and failing to recognize it as the case for which we had received payment of the maintenance fee, and since the time for payment had passed, although I have no specific recollection, either Mrs. Shepherd or myself made an entry to our docketing system showing the case as abandoned. I was unaware of this mistake until shortly after April 29, 2009 when we were notified by Mahle that the patent was expired, in spite of the fact that Mahle had sent the payment to us for the maintenance fee.

16. That on or about January 2008 I contacted the Des Moines office, who receives all payments on all accounts receivables, and asked that when they receive a payment for a maintenance fee, that I be notified. Usually, a copy of the maintenance fee due letter is returned with the client's payment so we know that the fee payment being made is actually for the payment of the current maintenance fee due. The Des Moines office sends me an e-mail stating that a particular client has paid the maintenance fee for the current maintenance fee due. At the time of the receipt of the e-mail, I pull the file copy of the letter retained in the Omaha office and mark in red ink the date the payment was received on the top of my copy of the letter. The letter is then placed in a follow up file which file is checked weekly. We do allow at least ten (10) days from deposit of the payment from the client for the payment to clear the bank. At least weekly, I check the aforementioned file to determine if the ten (10) days has passed, at which time I will pay the fee.

17. That since the three places where we normally check for pending matters, which is credit balances on our accounts, on our docketing system, and money deposited into our trust account, no pending maintenance fee for this particular Mahle case was showing. The accounts receivable was at a zero balance due to the Invoice submitted to Mahle prior to receipt of the payment, and then their payment of the Invoice. The docket was showing not showing the maintenance fee as pending, as it had been marked ABANDONED and no longer would show up on the print out of pending matters.

I declare that all of the statements made herein of my own knowledge are true, and that all statements made herein on information and belief are believed to be true, and further that those statements were made with the knowledge that willful false statements or the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Carolyn J. Campbell
Carolyn J. Campbell

Dated: *May 7, 2009*